

REMARKS

Status of Claims

Claims 1-12, and 14-16 are pending in this application. By this Amendment, claims 1, 3, 5 and 15 have been amended to correct the antecedent basis for the container appearance. Reconsideration is respectfully requested in view of the above amendments and the following remarks.

Substance of the Interview

Applicants thank examiners Bayerl and Bonshock for conducting the interview on March 1, 2005 and for considering the arguments regarding the deficiencies of the prior art, including Baecker and Poole. Among other things, we submit that the prior art fails to disclose a folder having an outer appearance on which graphical previews are located and displayed.

Official Notice and Traversal of finality

The Office Action has taken official notice with respect to the limitations of claims 9 and 10, which define a container having a background appearance and displaying a preview of the contents of the container on the background appearance of the container. The present invention allows a user to quickly and easily identify the contents of a container without opening the container.

“Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known. It would not be appropriate for the examiner to take official notice of facts without citing a prior art reference

where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known.” MPEP 2144.03(A) (2004).

The Office Action has not provided documentary evidence that meets the background appearance limitation; accordingly, the finality of the Office Action is traversed. Applicant challenges the Examiner to provide a reference detailing a container having a background appearance and displaying a preview of the contents of the container on the background appearance of the container. Applicant respectfully requests withdrawal of the finality of the office action.

Rejection under 35 U.S.C. §102(b)

Claims 1, 2, 7, and 8 were rejected under 35 U.S.C. § 102(b) as being anticipated by Baecker *et al.*, U.S. Patent No. 5,586,237 (hereinafter Baecker). This rejection is respectfully traversed.

With respect to independent claim 1, the Baecker reference does not teach a method for use on a computer that displays a graphical preview of an item on the **outer appearance of the container**, and that locates the graphical preview on the outer appearance in a desired location. The office action has referred to Fig. 6 and the accompanying discussion as anticipating the claimed invention. Baecker’s Fig. 6 discloses displaying previews of either icons or textual file names on an inner appearance of a folder icon. Unlike Baecker, claim 1 defines a graphical preview of an item contained in the container on the outer appearance of the container. This allows the user to identify contents of the container by viewing the outer appearance of the container. Accordingly, for at least the above reasons, claim 1 is allowable over the prior art.

Claim 2 depends from claim 1 and further defines novel features of the claimed invention. The Baecker reference does not disclose, “determining whether a graphical preview can be generated for each enumerated item.” Baecker discloses determining the display type, graphical or textual, for a folder. Baecker further discloses an animated icon that displays previews for all icons within the folder by displaying a colored square or icon symbol for each icon within the folder. Unlike Baecker, the present invention determines if an item can be graphically previewed and displays a graphical preview on the outer appearance of the container for the items that can be graphically previewed. Accordingly, for at least the above reasons, claim 2 is allowable over the prior art.

Claims 7 and 8 depend from claim 1 and further define novel features of the claimed invention. Accordingly, for at least the reasons set forth above, claims 7 and 8 are allowable by virtue of their dependence on claim 1.

Accordingly, because claims 1, 2, 7 and 8 define novel features over the art of record as set forth above, withdrawal of the rejection under 35 U.S.C. § 102(b) is respectfully traversed.

Rejection Under 35 U.S.C. §103(a)

Claims 3-6, 9-12, and 14-16 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Baecker and Poole, *Macword Mac OS 8.5 Bible*, (hereinafter Poole). This rejection is respectfully traversed.

Claims 3-6 depend from claim 1 and further define novel features of the claimed invention. Accordingly, for at least the reasons set forth above, claims 3-6 are allowable by virtue of their dependence on claim 1. Poole and Baecker fail to teach or suggest selecting items to display on the outer appearance of the container. Poole discloses a navigation or search dialog

box that enables a user to specify sort criteria. Poole further details a sort criterion is applied to the dialog box. Unlike Baecker and Poole, claims 3-6 include displaying a graphical preview of an item contained in the container on an outer appearance of the container, based on sort criteria. Accordingly, applicants respectfully request withdrawal of the § 103 rejection of claims 3-6 because these claims are novel and non-obvious over the prior art.

With respect to independent claim 9 Baecker and Poole, even if combined, would not result in the claimed invention. Neither Baecker nor Poole teaches or suggests a method that displays a textual message in addition to a background appearance and a graphical preview. Furthermore, both Poole and Baecker fail to teach or suggest determining whether an item can be graphically previewed on the background appearance of a container. Poole teaches a dialog box that displays an icon and text; however, the dialog box is not a background appearance of a container. The combination of Poole and Baecker fails to disclose determining if a graphical preview of an item can be displayed on the background appearance of the container, displaying the graphical preview of the item on the background appearance of the container and displaying a text message.

The combination of Baecker and Poole teaches away from the claimed invention. Baecker discloses that the display format is limited to either textual or graphical formats. Baecker does not disclose displaying both graphical and textual data simultaneously. Although Poole displays textual data there is no suggestion or motivation to modify Baecker to display both textual and graphical information. Accordingly, applicants respectfully request withdrawal of the § 103 rejection of claim 9 because this claim is novel and non-obvious over the prior art. Additionally, the examiner has taken official notice with respect to the background appearance

element; applicant has challenged the Examiner to provide a reference that discloses the claimed invention including the background appearance. MPEP 2144.03(C) (2004).

Claims 10-12 depend from claim 9 and further defines novel features, such as the background appearances, of the claimed invention. Both Poole and Baecker fail to teach or suggest a background appearance that is used to display a graphical preview of an item contained in a folder, wherein the background appearance is a photo album or a closed folder. Accordingly, applicants respectfully request withdrawal of the § 103 rejection of claims 10-12 because these claims are novel and non-obvious over the prior art. Also, the Examiner has taken official notice with respect to the background appearance limitation; applicant has challenged the Examiner to provide a reference that discloses the claimed invention including the background appearance. MPEP 2144.03(C) (2004).

Claim 14 depends from claim 9 and further defines novel features of the claimed invention. Accordingly, for at least the reasons set forth above, claim 14 is allowable by virtue of its dependence on claim 9.

With respect to independent claim 15, neither Baecker nor Poole nor a combination of Baecker of Poole teaches or suggests a method that displays a textual message in addition to a background appearance and a graphical preview on the background appearance. Both Poole and Baecker fail to teach or suggest displaying a graphical preview on the background appearance of the container. Poole discloses a dialog box that displays the contents of a folder and the Baecker reference discloses an animated icon that scrolls through the file names or icons within a folder. Baecker does not disclose or suggest an animated icon that displays both text and graphics. As noted above Poole teaches away from Baecker's disclosure of determining whether the display format is iconic or textual. Therefore, the combination of the Poole and Baecker fails to teach or

suggest a display provider capable of displaying a textual message and a graphical preview of the contents of a container on the background of the container. Accordingly, for at least the reasons set forth above, claim 15 is allowable over the prior art.

Independent claim 16, recites limitations similar to that of independent claim 9, which is fully discussed above. Therefore, independent claim 16 is allowable for at least the reasons set forth above with respect to independent claim 9.

To make a prima facie case of obviousness, the references must teach or suggest all the claim limitations. The combination of Baecker and Poole fail to teach or suggest the limitations of claims 3-6, 9-12, and 14-16. Therefore, for at least the reasons set forth above, applicants respectfully request withdrawal of the §103 rejection.

Conclusion

Applicants respectfully submit that the section 102(b) and 103(a) rejections have been overcome and claims 1-12, and 14-16 are now in condition for allowance. Allowance of all pending claims is respectfully requested. However, if the Examiner believes that any issues remain, he should feel free to contact the undersigned at the telephone number below.

Respectfully submitted,

Dated: April 7, 2005



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